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EXAMINER

FERRIS, DERRICK W

ART UNIT	PAPER NUMBER
2663	

DATE MAILED: 06/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/784,643

Applicant(s)

MISHRA, OM

Examiner

Derrick W. Ferris

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-28 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 1-6, 8-13, 15, 17-22, 25, and 26-28** are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,026,158 to *Bayless et al.* (“*Bayless*”).

As to **claim 1**, *Bayless* teaches an apparatus (i.e., either client 14 on a combination of client 14 and server 16 as 56) which has a media interface as part of display 72 as well as including stand alone applications 20 and a call handler as microprocessor 56. Since the applications run on the microprocessor 56, the examiner notes a reasonable but broad interpretation of coupled. Applicant discloses at page 9 of applicant’s specification examples of a media type as including voice, instant text messaging, multimedia (voice and image), and conferencing versions. As such, *Bayless* shows in figure 1 different media types including voice (i.e., telephony), e-mail, and video (also not shown but supported is conferencing, see e.g., column 1, lines 28-38). Finally, call feature selections are shown as 384, see e.g., figure 34.

As to **claim 2**, an example of requiring additional information is when making a conference call. In particular, the subscriber is prompted for the number of additional parties that the subscriber wishes to conference with, see e.g., column 36, lines 43-53.

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As to **claim 3**, see microprocessor 56 which is used for audio 26 in figure 2.

As to **claim 4**, see the video application 32 in figure 1.

As to **claim 5**, a conference call manager is shown as part of telephony 26. See e.g., conference controller 402 shown in figure 53.

As to **claim 6**, the voice mail manager is shown as part of voice mail 30 where information is stored either in (voice mail) database 22 or 40.

As to **claim 8**, see similar rejection to claim 1.

As to **claim 9**, see similar rejection to claim 2.

As to **claims 10-13**, using the example in One Step Conferencing Calling starting at column 36, line 35, the system accepts the call feature by displaying a conference dialogue window. The call feature selection and additional information is further accepted by the system when the user hits the dial button to dial the entered number (see figure 52). The call feature selection is further activated once the dial button has been entered and the call is placed. A call is then received by the called party and determined to be the originator when the caller answers the phone. It is important to note that applicant's specification is very vague with respect to steps 530, 532, 534, and 536.

As to **claim 15**, see e.g., figure 52 with respect to the "drop party" button.

As to **claim 17**, see similar rejection to claim 1. In particular, *Bayless* discloses a computer and thus a computer readable medium.

As to **claim 18**, see similar rejection to claim 2.

As to **claims 19-22**, see similar rejection to claims 10-13 respectively.

As to **claim 24**, see similar rejection to claim 15.

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As to **claim 26**, see similar rejection to claim 1. In particular, *Bayless* discloses a computer which is an apparatus.

As to **claim 27**, see similar rejection to claim 2.

As to **claim 28**, see similar rejection to claim 3.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 14 and 23** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent No. 6,026,158 to *Bayless et al.* ("*Bayless*") in view of U.S. Patent No. 5,907,604 to *Hsu*.

In making a proper obviousness rejection under MPEP 706.02(j), the examiner will address the following four steps:

- a) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line numbers where appropriate;*
- b) the difference of differences in the claim(s) over the applied cited references;*
- c) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter; and*
- d) an explanation why one skilled in the art at the time of the invention was made would have been motivated to make the proposed modification.*

As such to **claim 14**, for step (a) *Bayless* discloses the limitations in the base claim.

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For step (b) *Bayless* is silent or deficient to the further limitation the record containing a picture of the call originator and displaying the picture of the call originator when the matching record is found. In particular, *Bayless* looks up and displays information about the caller; however, the information displayed does not contain a picture of the caller.

Hsu teaches the further recited limitation above at e.g., see abstract.

For step (c), the proposed modification of the above-applied reference(s) necessary to arrive at the claimed subject matter would be to modify *Bayless* by including a picture of the user in the database as taught by *Hsu*.

In order to establish a prima facie case of obviousness for step (d), three basic criteria must be met. The three criteria according to MPEP 706.02(j) are as follows:

First there must be some suggestion or modification, either in the reference(s) themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

As such, for step (d) examiner notes that it would have been obvious to one skilled in the art prior to applicant's invention to include the further limitation the record containing a picture of the call originator and displaying the picture of the call originator when the matching record is found. In particular, the motivation for modifying the reference or to combine the reference teachings would be to associate an image with the caller ID information such as the caller ID information presented by *Bayless*. In particular, *Hsu* cures the above-cited deficiency by providing a motivation found at e.g., column 2, lines 1-15. Second, there would be a reasonable expectation of success since

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the image is associated with caller ID information as taught by *Bayless*. Thus the references either in singular or in combination teach the above claim limitation(s).

As to **claim 23**, see similar rejection to claim 14.

5. **Claims 16 and 25** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,026,158 to *Bayless et al.* ("*Bayless*") in view of U.S. Patent No. 5,689,641 A to *Ludwig et al.* ("*Ludwig*").

In making a proper obviousness rejection under MPEP 706.02(j), the examiner will address the following four steps mentioned previously.

As such to **claim 16**, for step (a) *Bayless* discloses limitations presented in the base claim.

For step (b) *Bayless* is silent or deficient to the further limitation sending the call originator a rejection notification when the call is rejected. Examiner notes that one may be implicitly taught since when the call is disconnected the user is notified since the call is dropped (e.g., the caller can no longer participate in the conference). However, assuming applicant clarifies a rejection notification, examiner notes the following obviousness rejection applies as well.

Ludwig teaches the further recited limitation above at e.g., column 37, lines 15-31. In particular, *Ludwig* discloses a REFUSE button that when activated will result in a message being displayed on the caller's screen indicated that the Expert (i.e., conference) is no longer available.

For step (c), the proposed modification of the above-applied reference(s) necessary to arrive at the claimed subject matter would be to modify *Bayless* by also

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- . teaching to place a message on the caller's screen when the drop button (i.e., REFUSE button) is pressed.

As such, for step (d) examiner notes that it would have been obvious to one skilled in the art prior to applicant's invention to include the further limitation sending the call originator a rejection notification when the call is rejected. In particular, the motivation for modifying the reference or to combine the reference teachings would be to notify the caller that the call has been terminated. In particular, *Ludwig* cures the above-cited deficiency by providing a motivation found at e.g., column 37, lines 15-31. Second, there would be a reasonable expectation of success since *Ludwig* also teaches a REFUSE button (i.e., drop button). Thus the references either in singular or in combination teach the above claim limitation(s).

As to **claim 25**, see similar rejection to claim 16.

Allowable Subject Matter

6. **Claim 7** is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Derrick W. Ferris whose telephone number is (703) 305-4225. The examiner can normally be reached on M-F 9 A.M. - 4:30 P.M. E.S.T.

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. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on (703) 308-5340. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DWF

Derrick W. Ferris
Examiner
Art Unit 2663



CHI PHAM
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600 6/24/09